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04 April 2006 Amendment
Responsive to 04 October 2005 Office Action

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REMARKS

This paper is responsive to any paper(s) indicated above, and is responsive in any other manner indicated below.

PENDING CLAIMS

Claims 1-5, 8 and 9 were pending, under consideration and subjected to examination in the Office Action. Appropriate claims have been amended, canceled and/or added (without prejudice or disclaimer) in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, such changes are unrelated to any prior art or scope adjustment and are simply refocused claims in which Applicant is present interested. At entry of this paper, Claims 1-5, 8 and 9 will be pending for further consideration and examination in the application.

CLAIM OBJECTIONS OBLIVIATED VIA CLAIM AMENDMENT

Claims 8 and 9 have been objected to because of the Office Action concerns listed within the section numbered "2" on page 2 of the Office Action. As amendments have been made where appropriate in order to address each of the Office Action listed concerns, reconsideration and withdrawal of the claim objection are respectfully requested.

REWRITTEN ALLOWABLE CLAIM

Claim 8 has been indicated as being allowable if rewritten, as indicated within the section numbered "5" on page 3 of the Office Action, and such claim has been so rewritten. Reconsideration and renewal of the allowance are respectfully

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requested. Applicant and the undersigned respectfully thank the Examiner for such indication of allowable subject matter.

'101 REJECTION AND 112 2ND PARA. REJECTION - TRAVERSED

Claims 1-5 and 9 have been rejected as improper "same claim product/process claims", as set forth in the sections numbered "3-4" spanning pages 2-3 of the Office Action. Traversal is appropriate.

It is respectfully submitted that Applicant's claims 1-5 and 9 are directed to proper "Product-By-Process" claims. More particularly, the Ex Parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), case, itself, states (Id. at p. 1552),

We however do recognize that certain types of claims which appear to be "hybrid" are permitted in U.S. patent practice. In particular, we refer to product-by-process claims. While this type of claim format may facially appear to cross the line between statutory classes of invention, we note that such is not the case. A product-by-process claim merely uses one statutory class of invention (i.e., process limitations) to define or fingerprint another statutory class (i.e., the product) which is not readily susceptible to definition soley by structure or physical characteristics. ...even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.

The claim in Ex Parte Lyell is different and distinguished from Applicant's present claims 1-5 and 9. More particularly, the preamble of Ex Parte Lyell's claim recited: "An automatic transmission tool in the form of a workstand and method for using the same comprising". That is, Ex Parte Lyell's applicant clearly was attempting to claim both the product (tool) and process (method) in the same claim. In contrast, Applicant's preamble ("A design support apparatus for a resin mold product made of thermosetting resin, comprising:") is directed only to the

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product (apparatus), and any process (method) limitations within the body of such claim are purely for "defining or fingerprinting" (in the words of the Ex Parte Lyell decision) the product.

MPEP 2173.05(p)'s section "I. PRODUCT-BY-PROCESS" states, "A claim to a device, apparatus, manufacture or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, as long as it is clear that the claim is directed to the product and not the process. It is respectfully submitted that Applicant's preamble makes it clear, that Applicant's claims are directed toward only to the apparatus.

Based upon the foregoing, reconsideration and withdrawal of the 101 and 112, 2nd para. rejections are respectfully requested.

EXAMINER INVITED TO TELEPHONE

The Examiner is herein invited to telephone the undersigned attorneys at the local Washington, D.C. area telephone number of 703/312-6600 for discussing any Examiner's Amendments or other suggested actions for accelerating prosecution and moving the present application to allowance.

RESERVATION OF RIGHTS

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer. That is, any above statements, or

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any present amendment or cancellation of claims (all made without prejudice or disclaimer), should not be taken as an indication or admission that any objection/rejection was valid, or as a disclaimer of any scope or subject matter. Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, i.e., Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims listed above as presently being under consideration in the application are now in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

To the extent necessary, Applicant petitions for an extension of time under 37 CFR 1.136. Authorization is herein given to charge any shortage in the fees, including extension of time fees and excess claim fees, to Deposit Account No.

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01-2135 (Case No. 566.42987X00) and please credit any excess fees to such deposit account.

Respectfully submitted,

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